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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,321	03/13/2001	Scott A. Hermreck	580745.004	1791

758 7590 10/31/2005

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EXAMINER
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LANEAU, RONALD

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/805,321

Applicant(s)

HERMRECK ET AL.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-29 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-29 and 40-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-29 and 40-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landry (US 5,649,117) in view of Wilkinson (US 2001/0034695 A1).

Landry teaches a computer-implemented method for tracking a personal finance system which includes a tracking system for charitable donations as seen in Figure 3 and col. 11, lines 31-46, "Transaction Reference An audit record used to retain and store Record information about each record sent out by the inventive system for which historical tracking, balancing and/or research is desired. For example, Payor Child-Transfer records, Payee Child-Transfer records and Pre-Notes sent out of the Reference Records. Voluntary Obligation A situation, commitment or arrangement under which a voluntary payment amount or series of voluntary payment amounts are expected to be paid. For example, Voluntary Obligation could include charitable donations, church donations, donations to a not for profit organization, or other voluntary payments." It is also clear that the system of Landry would inherently include data from more than one tax year. Landry does not teach the method of valuation of the donations but

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Wilkinson discloses a method for facilitating tangible valuation of intellectual property assets (non-cash donatable items) wherein the transaction may comprise any transaction mechanism known in the art including buying, selling, donating, etc. The tangible value may comprise fair market value, tax value, appraisal value, charitable donation value, etc (page 1, [0004]). Furthermore, Wilkinson discloses a market comprising means for accepting bids from one or more parties interested in acquiring one or more financial instruments representing an interest in one or more selected intellectual property assets (page 1, [0006]).

It would have been obvious to one of ordinary skill in the art to utilize the valuation system for intellectual property assets (non-cash donatable items) and the bidding system as disclosed by Wilkinson into the system of Landry because it would determine the market value per share of the intellectual property assets (non-cash donatable items) to be offered on the market and make the shares available for exchange on the market.

#### ***Response to Arguments***

4. Applicant's arguments filed on 08/24/05 have been fully considered but they are not persuasive.

Applicant argues that Landry does not disclose or suggest at least "storing in the memory data indicative of one or more non-cash donatable items and a tax deductible valuation." Contrary to Applicant's arguments, these particular features are all met by the newly added reference in Wilkinson. Applicant further argues that Landry does not disclose or suggest at least "updating said memory with a second set of data indicative of one or more non-cash donatable items and a tax-deductible value associated with each said non-cash donatable item for

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said current tax year. Again, Wilkinson provides updated market value and current tax value for the intellectual property assets (non-cashed donatable items) being stored in the memory. As a result, claims 1, 3-29 and 40-49 remain rejected.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Klasky et al (US 2002/0038225 A1) disclose a method and system for soliciting online donations.
- Price (US 2002/0120539 A1) discloses a method and system for distributing charitable donations at a point of sale to qualified donees.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Ronald Laneau*

Ronald Laneau

Examiner

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10/27/05

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